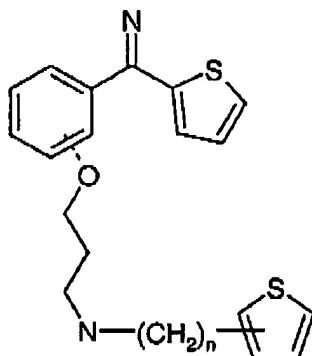


R_4 is H or C_{1-6} alkyl.

This group of compounds contain a core of:



Applicant asserts that this core defines a contribution over the art.

REMARKS

The present application entered the US national phase, through the PCT, under 35 USC 371. The present application was subjected to a restriction requirement purportedly under PCT Rule 13.1. Applicants assert that the restriction requirement is improper. Generally, the prosecution of an international application proceeds in the same manner as a domestic application. There is an exception relating to restriction practice. The standard set forth in MPEP 800 et seq. does not apply. Rather the "unity of invention" standard applies. (MPEP 1893.03).

The "unity of invention" standard is set forth in 37 CFR 1.475. See 37 CFR 1.499 and MPEP 1893.03 and 1895.01 (4). Accordingly, an international or national stage application shall relate to one invention only or to a group of inventions so linked as to form a single inventive concept. The requirement for unity of invention shall be fulfilled only when there is a technical relationship among the inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. 37 CFR §1.475(a).

Thus, in applying the "unity of invention" standard the invention or inventions of the application are considered according to the "special technical features." The requirement for unity of invention is fulfilled only when division is made among the inventions such that the technical relationship involving one or more of the same or corresponding special technical features is maintained.

In requiring the present restriction, the Examiner relies on the lack of a significant structural element qualifying as a special technical feature that defines a contribution over the prior art. Also, the Examiner argues the following: "[t]he core contains variables such as X, R1, R2, R3, Z, etc....The variables are broadly defined, and when the compound of formula I is taken as a whole, a plethora of vastly different compounds are possible. Each of the groups set forth above represents a discrete invention."

Applicant disagrees with the Examiner's statement that, when the compound of formula I is taken as a whole, a *plethora of vastly different* compounds are possible (emphasis added). Indeed, a significant structural element (identified by the Examiner as the core) is shared by all the alternatives in the genus. Applicant believes that the volume of subject matter encompassed by the genus of Claim 1 is reasonable and should not require restriction to a large number of inventions. The Examiner's statement that the listing of Groups I-VII "is not exhaustive" causes Applicant serious concern about the ultimate number of restrictions that will be required by the Examiner.

Applicant respectfully submits that the Groups of Claims designated by the Examiner fail to define "inventions" with "cores" or properties so distinct as to warrant separate examination and search. For example, with respect to Examiner's exemplary Group I, the special technical feature that defines a contribution over the prior art would be identical for compounds wherein X is O or X is N(CH₃). The Examiner arbitrarily restricted the compounds of Group I to only those compounds wherein X is N(CH₃). Furthermore, the combination of an independent claim for a given product, and an independent claim for a process specially adapted for the manufacture of said product, and an independent claim for a use of said product may also satisfy the requirement of unity of invention.

Applicants also wish to point out that the International Preliminary Examination Report in the international phase of the PCT application indicates that no lack of unity of invention was found. Restriction of the novel compounds of the instant application should not in any way narrow the field of search. As taught by the Manual of Patent Examining Procedures, (MPEP 904.01(d)), an appropriate field of search should include every class and subclass that may have material pertinent to the subject matter as claimed. Furthermore, a search of the prior art has already been done in the international phase of this PCT application, and that search included all of the compounds, compositions and methods of use now claimed in the national phase.

CONCLUSION

Applicant respectfully asserts that the required restriction between Groups I-VII is improper. Accordingly, withdrawal of the Requirement for Restriction, or in the alternative a modification thereof, is respectfully requested. A complete search has already been made in the international phase of this application.

Respectfully submitted,



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